Remarks:

Claims 1-3, 6-8 and 11-13 are now pending. Claims 1, 6, and 11 have been amended to better describe the invention and Claims 4, 5, 9 10, 14, 15, and 16 have been canceled. The examiner rejected claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over Barry - GB622970 because "One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by varying the reactants, ratio of the reactants and nonreactants, the solvent and reaction conditions from the teaching of Barry to arrive at the instantly claimed process for preparing diphenylchlorosilanes by the Grignard practice."

Applicants have amended the claims to specify the chlorosilane materials useful in the invention and also specify toluene as the coupling solvent. Unlikely Barry, Applicants' invention does not involve the use of any hydridochlorosilane. It is well known in the art that hydridochlorosilanes are very different in reactivity and selectivity than other chlorosilanes that do not contain hydrogen. Further, although Barry described using benzene in the examples, there was no discussion in the specification that this was a required ingredient – unlike in the present invention. Specifically, Barry states in Column 2 lines 55 to 62 that "the present invention consists of reacting an inorganic trihalosilane or, a mono-organo-dihalosilane containing one of the desired R or R' substituents, with at least its desired molecular equivalent of an organomagnesium halide containing one or more of the desired R or R' substituents, in the presence of ether as a reaction medium." Barry did not recognize or disclose the benefit of having a coupling solvent in addition to the ether. In the present invention, not only is the toluene required, it is required to be in a certain ratio relative to the Grignard reagent, i.e. 3 to 7. Applicants invention requires ensuring all the materials added to the reaction are present in certain ratios in order to maximize the quantity of diphenylchlorosilane and it uses chlorosilanes different from that required by Barry. Applicants assert that the instantly claimed process would not have been suggested to one of ordinary skill based on the teachings of Barry.

For all the above reasons, Applicants believe, the present invention is not prima facie obvious over Barry, and respectfully request that the Examiner allow claims 1-3, 6-8, and 11-13.

The examiner also provisionally rejected claims 1-16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/585,155 in view of Nguyen et al. Applicants have amended the claims so that the aromatic coupling solvent is toluene. Applicants do not believe there is any potential overlap with the scope of copending application 10/585,155 which requires an aromatic halogenated coupling solvent and therefore Applicants respectfully request that the Examiner withdraw this provisional double patenting rejection.

This reply is being submitted within the period for response to the outstanding office action. Applicants believe in good faith that only a two (2) month extension of time is needed, however the applicants hereby petition for the two month extension of time and any required additional extensions of time. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application. You are authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to deposit account 04-1520.

Respectfully Submitted,

Dow Corning Corporation

Patricia M Scaduto

Patricia M. Scaduto
Reg. No. 39,827
Tel: 989-496-6925